

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 23, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pizzeria Uno Corporation
v.
Benziger Family Ranch
doing business as
Benziger Family Winery

Opposition No. 99,231
to Application No. 74/619,491
filed on December 1, 1994

John L. Welch of Dike, Bronstein, Roberts & Cushman for
opposer.

Paul W. Vapnek of Townsend and Townsend and Crew for
applicant.

Before Hanak, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Pizzeria Uno Corporation ("Pizzeria Uno") filed its
opposition to the application of Benziger Family Ranch

d.b.a. Benzinger Family Winery ("Benziger") to register the mark BRUNO for "beer" in International Class 32.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered mark PIZZERIA UNO for restaurant services and various other UNO marks for restaurant services and for food items, including pizza, calzone, salad and soup, and opposer's previously used and registered design mark incorporating the word BRUNO, as shown below, for restaurant services as to be likely to cause confusion, under Section 2(d) of the Trademark Act.



Applicant, in its answer, denies the salient allegations of the claim. However, applicant admits that beer is served in restaurants; and that the above-displayed

¹ Application Serial No. 74/619,491, filed December 1, 1994, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

design is a caricature of a young boy on a skateboard with the word "Bruno" on the bottom of the skateboard, but denies that such is a "BRUNO mark" or that a likelihood of confusion exists between this mark and applicant's mark. Applicant asserts as "affirmative defenses"² that there is no likelihood of confusion between its mark BRUNO for beer and opposer's PIZZERIA UNO and UNO marks for restaurant services; and that applicant's services are known to the public under the mark PIZZERIA UNO.

The Record

The record consists of the pleadings; the file of the involved application; various excerpts from printed publications, made of record by opposer's notice of reliance; and the testimony deposition by opposer of Aaron D. Spencer, opposer's CEO and chairman, with accompanying exhibits. Applicant filed no evidence or testimony. Only opposer filed a brief on the case and a hearing was not requested.

The Parties

Opposer owns and franchises restaurants located throughout the United States. The restaurants are known as "Uno" and "Pizzeria Uno." Opposer's first restaurant

² While not truly "affirmative defenses," applicant's statements have been considered as amplifications of its position.

opened in Boston in 1977. Mr. Spencer estimated that opposer's system-wide sales for 1996 were expected to be between \$250 million and \$300 million; that, system-wide, opposer expects to serve 30 million customers in 1996; and that, since 1979, opposer's restaurants have served between 250 million and 500 million customers, with 100 million customers having been served since 1992. Opposer's advertising promotes a type of pizza known as "Chicago deep-dish pizza," although opposer's restaurants offer a variety of foods, as well as beer. Opposer uses its UNO mark on signs, menus, paper products, and staff clothing and on packaging for food products, for example, salad dressings, calzone and pizza sold through grocery stores. Opposer uses its mark also in print, radio and television advertising. It uses its UNO mark in combination with other words to describe menu items, for example, "Uno" and "Numero Uno" for pizza, "Café Uno" for coffee, "Uno Colada" for an alcoholic beverage, and "Puncheruno" for Sangria. Opposer serves a number of different brands of beer in its restaurants, including its own brand, on tap since 1995, "Uno Amber Ale."

Since July 1992, opposer has used the design mark shown above as a mascot to appeal to children. The design appears on children's cups and coloring books, on gift

certificates and table advertisements, and is featured on the back of opposer's menu beside the children's menu. An entrée on the children's menu is "Bruno Pasta."

There is no evidence or testimony regarding applicant in the record. Thus, from this record, we can conclude only that applicant has a bona fide intention to use the mark BRUNO in connection with beer.

Analysis

Mr. Spencer, opposer's witness, testified that, since prior to the filing date of the application herein, the mark UNO has been used in connection with restaurant services and food products, including pizza, calzone, salad, soup and pasta; that the mark UNOWEAR has been used in connection with various items of clothing; and that the marks PIZZERIA UNO, NUMERO UNO, THE UNO WAY and the design mark incorporating the term BRUNO, as shown above, have been used in connection with restaurant services. In view of the testimony by Mr. Spencer regarding opposer's ownership and status of three of the six pleaded registrations³ and his testimony regarding opposer's use of

³ Registration No. 1,329,014 for UNO for restaurant services, issued on April 2, 1985. Registration No. 1,613,333 for NUMERO UNO for restaurant services issued on September 11, 1990. Registration No. 1,795,389 for the design mark incorporating the term BRUNO, as shown above, for restaurant services issued on July 28, 1993. [Sections 8 and 15 affidavits have been accepted and acknowledged, respectively, with respect to each of these registrations.]

its marks, there is no question that opposer's marks have priority in connection with restaurant services and various items of clothing and food vis-à-vis applicant. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, opposer's 1995 use of its UNO mark on beer is subsequent to the filing date of this application, thus, opposer does not have priority in relation to the use of its mark on beer.

We turn, next, to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations in this case are the similarities between the marks and the similarities between the goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning, first, to the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is

nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposer contends that its UNO marks comprise a family of marks and that its UNO mark is famous. Regarding opposer's family of UNO marks allegation, it is well settled that the mere ownership of a number of marks showing a common feature is insufficient to establish a claim of ownership of a family of marks characterized by the "UNO" feature in the absence of evidence that the various marks said to constitute the family were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. *See, Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987). The materials submitted by opposer demonstrating the extent and nature of its use of the various marks are insufficient to demonstrate that the general public would regard the "UNO" marks as a family of marks owned by opposer. *Compare, J&J Snack Foods, Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

Regarding establishing that its UNO mark is famous, the record contains insufficient evidence in support of opposer's allegation that this trademark is famous in connection with restaurant services and, thus, would be entitled to "a wide latitude of legal protection." *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992).

We consider, first, opposer's UNO mark. We take judicial notice of the translation by *Cassell's Italian-English Dictionary* (1977) of the Italian word "uno" into English as "one." This translation/meaning of the term is the likely connotation of UNO to consumers, particularly as it appears in opposer's mark NUMERO UNO. Applicant's mark, on the other hand, is BRUNO, which is defined in *The Random House Dictionary of the English Language*, 2nd ed., unabridged (1988) as "3. a male given name: from a Germanic word meaning 'brown.'" Thus, BRUNO is likely to be understood by consumers as a name. While the name BRUNO includes the word UNO in its entirety, we find that the addition of the prefix "BR" to UNO to create the word BRUNO substantially changes the connotation, sound and commercial impression of the term. Thus, we find that UNO and BRUNO are not similar, even if used or proposed to be used on the

same, similar or related goods and/or services. This conclusion is equally applicable to opposer's other UNO marks, such as PIZZERIA UNO and NUMERO UNO.

We consider, next, opposer's design mark shown above. As applicant noted in its answer, this is clearly a caricature of a young boy, or at least of a child who is clearly not of an age to consume alcoholic beverages. Opposer's UNO trademark appears on the boy's shirt and he is riding a skateboard. The word BRUNO appears on the bottom of the skateboard. The word BRUNO appears to name the skateboard rather than the boy; and the boy is clearly the dominant part of the mark. While words often predominate over design elements in a mark, we believe this is a case where the word BRUNO is not a dominant portion of the mark. Rather, the commercial impression of the mark is of an unnamed young boy wearing an UNO shirt and happily riding a BRUNO skateboard. While the word on the skateboard is identical to applicant's mark, the commercial impressions of the two marks, considered in their entireties, are not substantially similar.

Thus, we turn to consider the goods and services of the parties. Opposer contends that the goods and services of the parties are identical. However, as previously noted, while opposer has sold its own Uno Amber Ale in its

restaurants since 1995, this use of its UNO mark does not predate the filing date of the application in this case. Thus, in determining likelihood of confusion in this case, we are considering the similarity of opposer's restaurant services⁴ identified by its various UNO marks and its design mark to applicant's proposed beer product. We consider opposer's evidence that it serves beer in its restaurants, and that it serves a house brand of beer called Uno Amber Ale, simply as supportive of our conclusion that, as applicant admits, beer is often served in restaurants and, further, that at least opposer's restaurants serve a "house" brand of beer that incorporates the restaurant's UNO trademark in its name. However, this evidence does not establish a sufficient relationship between restaurant services and beer products to warrant a conclusion that confusion is likely when opposer's identified marks are used in connection with restaurant services and applicant's BRUNO mark is used on beer. Thus, we find that opposer has not established a likelihood of confusion in this case.

⁴ While opposer establishes use of its UNO marks on several food products and clothing items, there is no evidence in the record regarding any relationship between these products and beer. Nor do we find these products to be sufficiently similar or related such that confusion would be likely if these goods were identified by similar marks.

Decision: The opposition is dismissed.

E. W. Hanak

C. E. Walters

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board